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10/579,678

05/18/2006

Efraim Haimoff

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THE NATH LAW GROUP
112 South West Street
Alexandria, VA 22314

EXAMINER

THROWER, LARRY W

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

05/27/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/579,678 | Applicant(s) HAIMOFF, EFRAIM | |
| | Examiner LARRY THROWER | Art Unit 1791 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 1-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group 3, claims 24-32 in the reply filed on February 12, 2010 is acknowledged. Applicant argues that the amendment of claim 24 now includes all of the limitations of claim 1 and therefore does not lack unity. However, as set forth by the previous examiner, the features common to claims 1 and 24 do not define a contribution over the prior art, and therefore unity of invention is lacking between the two groups. Applicant has failed to traverse the reasons for the holding of the lack of unity.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-23 are withdrawn; claims 24-32 are under examination.

Information Disclosure Statement

2. The information disclosure statement filed June 27, 2006 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information lined through therein has not been considered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 24-32** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- The term "relatively wide" in claim 27 is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.
- The term "snugly" in claim 24 renders the claim indefinite for being unclear as to the type of fit the structural elements are intended to have.
- Claim 29 recites the limitation "the rigid core." There is insufficient antecedent basis for this limitation in the claim.
- The term "thin" in claim 31 is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 24-32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Duret et al. (US 4,053,126).

- **Claims 24-25:** Duret et al. discloses manufacturing a composite article including a metal reinforcing element (42) and molded plastic coating firmly attached thereto (abstract), wherein the reinforcing element (42) is formed to define an open channel having a longitudinal axis and an open side parallel to the axis (fig. 13), and the plastic coating includes a portion formed as a wall mechanically closing the open side of the channel (col. 5, line 63 - col. 6, line 6; fig. 13), where the form of the metal reinforcing element allows insertion via the open side of the channel of a mold core snugly fitting the reinforcing element (fig. 13). The method includes providing the metal reinforcing element (42); providing the mold core (col. 4, lines 49-59), providing a mold (9) including at least two parts formed to define a mold cavity therebetween when the mold is assembled (col. 3, lines 3-11), the mold being adapted to accommodate the metal reinforcing element fixedly in the mold cavity and allowing space for the plastic coating (col. 3, lines 12-26); inserting the mold core in the metal reinforcing element (col. 4, lines 50-59); assembly the mold parts and the metal reinforcing element with the inserted core therein so as to fix the reinforcing element in the mold cavity (fig. 13); injecting flowable and settable plastic coating into the space to form the composite article (col. 4, lines 13-25); releasing the obtained article including the reinforcing element, the set plastic coating and the

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mold core by disassembling the mold 9 (col. 3, lines 3-11); and removing the mold core from the article (col. 4, lines 49-59).

- Duret et al. is silent as to the direction of inserting or removing the mold core.

However, absent unexpected results from inserting and/or removing the core in the claimed directions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have inserted and/or removed the mold core in any selected direction relative to the metal reinforcing element as long as the core remained stationary in the mold throughout the duration of the molding procedure and was removable when the molding procedure was complete, such that the metal reinforcing element was protected from the plastic coating by the core, as taught by Duret et al. (col. 4, lines 49-59).

- **Claim 28:** Duret et al. discloses the reinforcing element having openings which are filled by the injected plastic coating (col. 4, lines 12-25; fig. 13).
- **Claims 26-27 and 29:** Duret et al. is silent as to the shape of the core or protrusions on the mold. However, there is no invention in merely changing the shape or form of an article without changing its function except in a design patent (see *Eskimo Pie Corp. vs. Levous et al.*, 3 USPQ 23 and *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)).
- **Claim 30:** Duret et al. discloses the mold core being assembled from at least two parts divided along a channel for the purpose of demolding the article (col. 3, lines 5-10).

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- **Claims 31-32:** Duret et al. is silent as to the claimed dimensions of the coating.

However, absent evidence of unexpected results obtained from a coating of the claimed thickness, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected a suitable coating to effectively produce the article, the thickness being a result effective variable routinely optimized by those of skill in the art and recognized as such by Duret et al. (col. 4, lines 27-31). The optimization of a range or other variable within the claims that flows from the “normal desire of scientists or artisans to improve upon what is already generally known” is *prima facie* obvious. *In re Peterson*, 315 F.3d 1325, 1330 (Fed. Cir. 2003).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LARRY THROWER whose telephone number is 571-270-5517. The examiner can normally be reached on Monday through Friday from 9:30AM-6PM est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina A. Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Larry Thrower/
Examiner, Art Unit 1791

/Christina Johnson/
Supervisory Patent Examiner, Art Unit 1791